

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)	Art Unit: GILLES 2
)	
Dominique GILLES)	Examiner:
)	
Serial No.:10/578,256)	Washington, D.C.
)	
IA Filing Date: March 3,2005)	October 15, 2008
)	
For: SANDING ELEMENT...)	Conf. No.:6713

RESPONSE TO AND PETITION TO VACATE ERRONEOUS NOTIFICATION OF MISSING REQUIREMENTS

U.S. Patent and Trademark Office
Customer Service Window
Randolph Building, Mail Stop Missing Parts
401 Dulany Street
Alexandria, VA 22314

Sir:

Applicants are in receipt of a Notification of Missing Requirements Under 35 U.S.C. 371, dated August 15, 2008, which indicates that the declaration as filed with the national stage entry does not identify the international application and international filing date. It is respectfully requested that this notification be vacated as improvidently issued because the declaration is proper under the Rules.

THE FACTS

The declaration submitted with the national stage entry is a copy of the declaration submitted under PCT Rule 4.17(iv) during the prosecution of the PCT application (PCT/IB2005050799). The declaration was timely filed, accepted and made of record in the PCT, as evidenced by the statement on the second page of the publication (courtesy copy attached), which states:

Declaration pursuant to Rule 4.17:
- Declaration of Inventorship (Rule 4.17(iv)) for US only

ARGUMENTS

With regard to the allegation that the declaration does not identify the application by the international application number and the international filing date, this declaration does identify the international application number, when it states in the second paragraph “This declaration is directed to international application PCT/IB2005/050799 (if furnishing declaration pursuant to Rule 26ter).” While it does not identify the international filing date, the declaration is merely a copy of the document as filed and accepted in the PCT application.

There is no need for a new declaration if one has previously been filed in the PCT application, as evidenced by the declaration requirements as set forth in 37 C.F.R. § 1.495(c)(1)(ii) (emphasis added), which provides that a notice of missing parts will be sent for:

(ii) The oath or declaration of the inventor (35 U.S.C. 371(c)(4) and § 1.497), **if a declaration of inventorship in compliance with § 1.497 has not been previously submitted in the international application under PCT Rule 4.17(iv) within the time limits provided for in PCT Rule 26ter.1; ...** [Emphasis added]

Because the declaration is clearly referenced on the second page of the title page of the PCT publication, the document was timely received by the International Bureau, and met all the requirements as set forth under PCT Rule 4.17(iv). Nothing further is required.

Applicants submit that in view of the above comments, the notice of missing parts should be vacated, the application given a filing date under 35 USC 371(c), and the

application be sent to an examiner for prosecution on the merits. If there are any remaining questions, the Office is requested to contact to the undersigned to facilitate resolution.

Favorable consideration is respectfully requested.

If the present petition is granted and the Notice of Missing Requirements is vacated, then no extension of time fee will be due. If it is determined that an extension of time fee must be paid for the present petition to be considered, and/or, if any petition or other fee is deemed due in order for this petition to considered and/or granted, please consider this to be a request for such an extension of time and charge any required fees to deposit account no. 02-4035 of the undersigned.

Respectfully submitted,

BROWDY AND NEIMARK, P.L.L.C.
Attorneys for Applicant

By: /Ronni S. Jillions/
Ronni S. Jillions
Reg. No. 31,979

624 Ninth Street, N.W.
Washington, D.C. 20001
Telephone: (202)628-5197
Facsimile: (202)737-3528
RSJ:gt
Enclosures: Copy of WO 2005/087436